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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,001	12/10/2003	Brett Mezen	273402004900	9445
25226	7590	09/19/2006	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,001

Applicant(s)

MEZEN ET AL.

Examiner

Kim T. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura (US 6,988,732).**

Claim 1: Vancura discloses a gaming machine comprises a display; a game controller for playing a game wherein at least one random event is displayed on the display; and a selector applicable to a game feature, upon a trigger condition occurring in a base game, a player is afforded an opportunity of predicting an outcome of the feature and if the player's prediction is correct, a bonus is awarded to the player (col. 10, lines 16-20, 35-51 and 56-65; col. 19, lines 37-67; col. 20, lines 1-14; col. 5, lines 23-30; col. 10, lines 1-12; col. 11, lines 4-12 and 45-55). Vancura does not explicitly disclose awarding a prize if a predefined winning event occurs. However, since Vancura discloses awarding awards or payoffs if a predefined winning event occurs (col. 19, lines 46-49; and col. 21, lines 57-59), and since it would have been well known that an awards or payoffs could be any prizes, Vancura obviously encompasses awarding a prize to the player in order to encourage players to play the game.

Claim 2: Vancura discloses a series of free games (i.e. series of questions) (col. 15, lines 45-47; and col. 20, lines 6-9).

Claim 3: Vancura discloses allowing the player to make a prediction that constitutes one of a number of possible outcomes of game features (i.e. The Price Is Right game, Family Feud game, Trivial Pursuit game, Proximate Responses, or Puzzles game, etc.).

Claims 4-5: setting a specific prediction game corresponding with a specific outcome and requiring a player to predict the outcome of the specified prediction game would have been both well known and obvious design choice according to a designer's preference.

Claims 6-7: Vancura discloses relating the bonus award to the degree of difficulty of achieving the outcome (col. 15, lines 20-21).

Claim 8: Vancura discloses displaying information related to the outcome (i.e. payout chart) (col. 11, lines 7-12).

Claim 9: Vancura discloses including a touch screen for enabling the player to select an icon (col. 11, lines 45-50; and col. 20, lines 12-14).

Claim 10: awarding a bonus award which is multiplied by the wager in the base game would have been well known to a person of ordinary skill in the art at the time the invention was made.

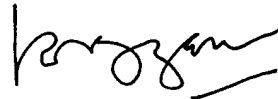
Claims 11-20, refer to discussion in claims 1-10 above.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

kn  
Date: September 14, 2006



Kim Nguyen  
Primary Examiner  
Art Unit 3713